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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1947.

No. 399

NATIONAL PRESSURE COOKER COMPANY,
a corporation,
Petitioner,

vs.

ALUMINUM GOODS MANUFACTURING COMPANY,
a corporation,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner respectfully prays that the writ of certiorari issue to the United States Circuit Court of Appeals for the Seventh Circuit to review a judgment of that Court entered in this case on April 19, 1947 (R. p. 373), reversing a judgment of the United States District Court for the Northern District of Illinois, Eastern Division.

A petition for rehearing (R. p. 375) was filed in the Circuit Court of Appeals for the Seventh Circuit on May 5, 1947, and denied on July 16, 1947 (R. p. 397).

A certified transcript of the record in this case, including the proceedings in and the opinion of the said Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

I.

SUMMARY STATEMENT OF MATTERS INVOLVED.

(A) Jurisdictional Statement.

Jurisdiction is invoked under Section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended, and Rule 38 (5) (b) of the Supreme Court of the United States. The decree to be reviewed was entered on April 19, 1947 (R. p. 373). A petition for rehearing was filed on May 5, 1947 and denied on July 16, 1947 (R. p. 397).

(B) Nature of Action and Summary of Facts.

This is an action for patent infringement, brought by Petitioner in the United States District Court for the Northern District of Illinois, Eastern Division, to enjoin infringement of the Wittenberg patent No. 2,218,188 (R. p. 250), entitled "Pressure Cooker", which issued to Petitioner October 15, 1940.

Respondent counter-claimed, alleging that all the claims were invalid, but if valid were not infringed. The Trial Court held claims 1 and 2 valid and infringed, claims 3, 4 and 5 invalid and claim 6 valid but not infringed. (Letter of opinion, R. p. 226, Findings of Fact and Conclusions of Law, R. p. 231 and Judgment R. p. 235).

From this judgment, holding claims 1 and 2 valid and infringed and claim 6 valid, Respondent appealed to the Circuit Court of Appeals for the Seventh Circuit. The Circuit Court of Appeals in a judgment entered on April

19, 1947 (R. p. 235), reversed the District Court and held claims 1, 2 and 6 invalid for want of invention. A petition for rehearing was denied by the Circuit Court on July 16, 1947 (R. p. 397).

Briefly stated, the record shows the defendant urged lack of invention over some twenty-five paper patents, no one of which was shown ever to have been used. The plaintiff urged that invention was shown by the great improvement in the practical art, in view of the admitted facts that while each element of the combination claims was old, the combination was new. It plainly appears that prior art cookers were not satisfactory, that plaintiff's employees over a period of years made many efforts to improve its product and that it was on the coming of the Wittenberg invention that the problems of safety, convenience and cost were solved. The evidence showed that the defendant twice was urged to make prior art pressure cookers. It did not do so. The Wittenberg pressure cookers came on the market in November, 1939. This provoked Respondent's interest. It then came into the field with the accused cookers.

The Trial Court found (R. pp. 232-233) that Wittenberg pressure cookers had a greater utility, simplicity, safety and economy than existed in the prior art. It found that Wittenberg produced a "new result." In pursuit of these findings and the proof of immediate public acceptance of the Wittenberg cookers, the Trial Court held claims 1, 2 and 6 valid.

The Circuit Court of Appeals expressly agreed that the Wittenberg pressure cooker "possessed a greater utility than any of its predecessors, it was safer, simpler and easier to operate, cost less to manufacture and required less expense for repairs and servicing" (R. p. 366). However, the Circuit Court of Appeals did not agree with the

Trial Court's finding that a "new result" had been produced, because prior art pressure cookers had cooked foods. Further, the Circuit Court of Appeals found that in the course of prosecution in the Patent Office, the claims had been amended, and judged the invention, not by comparing the combination claims, as allowed, with the prior art, but by comparing the claims as amended with the claims prior to amendment. On the basis of its own finding, contrary to the finding of the Trial Court, that there was no "new result," and on the basis of its postulate that a rejected application claim—not prior art in fact—*ipso facto* became prior art when amended, the Circuit Court of Appeals found no invention.

(C) Questions Presented.

1. Has the Circuit Court of Appeals for the Seventh Circuit applied a new requirement in holding that a patent on a cooking utensil to be valid must, in addition to producing a "new result" in a cooking utensil, produce a "new result" on the unpatented food with which its use is contemplated?

2. Has the Circuit Court of Appeals for the Seventh Circuit, in disregarding the fact finding by the Trial Court that the patent in suit secured a "new result," departed from Rule 52 (a) of the Federal Rules of Civil Procedure?

3. Has the Circuit Court of Appeals for the Seventh Circuit applied an erroneous postulate that a claim in a patent application, not itself prior art, becomes such if the applicant amends it?

(D) Reasons Relied On for the Allowance of the Writ.

1. The Circuit Court of Appeals below has decided important questions of Federal Law in a way probably in conflict with the applicable decisions of this Court.

While expressly finding that cookers made under the patent in suit had a greater utility than any of its predecessors, were safer, simpler, easier to operate, cost less to manufacture and required less expense for repairs and servicing, the Circuit Court of Appeals found that no "new result" was produced. In *Webster Loom Company* v. *Higgins*, 105 U. S. 580, 591, 592, 26 L. Ed. 1177 (1882) this Court in its opinion by Mr. Justice Bradley stated:

> "* * * It was certainly a new and useful result to make a loom produce fifty yards a day when it never before had produced more than forty. * * *"

In subsequent decisions this Court has uniformly given a similar interpretation to the words "new result."

2. The Circuit Court of Appeals below has decided an important question of Federal Law in a way probably in conflict with the applicable decisions of this Court and of other Circuit Courts of Appeal and also in conflict with Rule 52 (a) of the Rules of Civil Procedure.

The Circuit Court of Appeals set aside the findings of the Trial Court that Wittenberg secured a "new result," and made an invention without considering whether the findings were "clearly erroneous." While this Court has not passed upon the question since the adoption of the Rules of Civil Procedure, its former decisions and decisions of other Circuit Courts of Appeal are contrary to the decision below.

3. The Circuit Court of Appeals below has decided an important question of Federal Law in conflict with deci-

sions of other Circuit Courts of Appeal, which question has not been, but should be, settled by this Court.

This Court has never considered significant an amendment of a claim in a patent application, except on the issue of *infringement*. The Circuit Courts of Appeal for the Second and Sixth Circuits have each declined to consider such an amendment on the issue of *validity*, holding that the claim finally allowed should be judged on the prior art as it existed in fact. The Circuit Court of Appeals below has held that a claim must show invention over the prior art as it existed in fact, and also, in the event that it was amended during prosecution, over the claim as it read prior to amendment.

WHEREFORE, it is respectfully submitted that this petition for a writ of certiorari to review the judgment of the Circuit Court of Appeals for the Seventh Circuit should be granted.

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE CIRCUIT COURT OF APPEALS APPLIED A NEW REQUIREMENT FOR PATENTABILITY IN CONFLICT WITH APPLICABLE DECISIONS OF THIS COURT.

The Trial Court found that the Wittenberg patent secured a new result and was an invention. The Circuit Court of Appeals reversed these findings on the basis of its limiting the meaning of "new result" far beyond its reasonable limits, and in conflict with applicable decisions of this Court. The Circuit Court of Appeals said in its opinion (R. p. 366):

> "* * * Certainly the record discloses that plaintiff's cooker manufactured under the patent in suit possessed a greater utility than any of its predecessors, it was safer, simpler and easier to operate, cost less to manufacture and required less expense for repairs and servicing. We are of the opinion, however, that the record fails to support the finding that a 'new result' was produced. In fact, we think that such was not the case. The purpose to be served by any pressure cooker is to transform raw foods into those fit and proper for human consumption. We find nothing in the record to indicate but that this result was satisfactorily obtained by cookers in existence and use at the time of plaintiff's claimed invention."

In this, the Circuit Court of Appeals held that if the broad purpose of a patented device has been served by a prior art device, no "new result" can be secured—regardless of increased utility, safety, convenience and economy. This Court has held to the contrary.

The leading case in which this Court sustained a patent because it secured a "new result" is *Loom Co.* v. *Higgins*,

105 U. S. 580 (1881). In that case, this Court in its opinion by Mr. Justice Bradley indicated clearly that the "new result" which will sustain a patent is a "new result" in the sense of an "improved result", at pages 591 and 592 as follows:

> "* * * *It was certainly a new and useful result to make a loom produce fifty yards a day when it never before had produced more than forty;* and we think that the combination of elements by which this was effected, even if those elements were separately known before, was invention sufficient to form the basis of a patent." (Emphasis supplied.)

More recently this Court in *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364 (1942) held that a greater adjustability in a shoe lasting machine was a new result. In its opinion by Mr. Justice Roberts this Court used the words "improved result" and "new result" as synonomous at page 367:

> "* * * These findings are to the effect that the new combinations, while they involve old mechanical constructions, combine these in a new way so as to produce an improved result. These are findings of fact, despite the petitioner's apparent contention to the contrary, and we will not disturb such concurrent findings where, as here, there is evidence to support them. The claim that the combinations are merely of old elements, which perform no new function and produce no new result, must be overruled."

There are many other decisions of this Court with which the decision of the Circuit Court of Appeals herein is in conflict. Among them is *Abercrombie & Fitch Co.* v. *Baldwin*, 245 U. S. 198 (1917) in which this Court held valid and infringed a patent on a carbide lamp. It might have been said that the purpose to be served by any carbide lamp is to transform chemicals into light. Such result was old. Carbide lamps were old. But this Court sustained the patent,

expressly approving the decision of the District Court in which safety and simplicity of construction and operation were stated to be "controlling considerations."

In *Hildreth* v. *Mastoras,* 257 U. S. 27 (1921) this Court held valid and infringed a patent on a candy pulling machine. The purpose to be served by any candy machine is to transform sugar and other materials into candy. This result was old. But this Court sustained the patent because of increased sanitation, and reduced cost. The Circuit Court of Appeals herein while conceding the contributions of increased safety, utility, convenience, and economy, denied patentability to Wittenberg because Wittenberg was not the first to cook food.

The Patent Act expressly provides for the patentability of "improvements" (U. S. Code, Title 35, Sec. 31). The test applied by the Circuit Court of Appeals would deny patentability to any improvement on the ground of a "new result". The applicable decisions of this Court are to the contrary.

THE ACTION OF THE CIRCUIT COURT OF APPEALS IN REJECTING THE FINDINGS OF THE TRIAL COURT IS IN CONFLICT WITH DECISIONS OF THIS COURT AND OTHER CIRCUIT COURTS OF APPEAL AND IS ALSO IN CONFLICT WITH RULE 52(a) OF THE FEDERAL RULES OF CIVIL PROCEDURE.

Rule 52(a) of The Rules of Civil Procedure provides:

> "* * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses * * *."

This rule preserves the same distinction in function between trial court and court of review which have existed for many years. This court in its opinion by Mr. Justice Shiras in *Dooley* v. *Pease,* 180 U. S. 126, 131-132, 45 L. Ed. 457 (1901) stated the rule:

"Where a case is tried by a court, a jury having been waived, its findings upon questions of fact are conclusive in the courts of review, it matters not how convincing the argument that upon the evidence the findings should have been different * * *."

"Errors alleged in the findings of the court are not subject to revision by the Circuit Court of Appeals, nor by this court, if there was any evidence upon which such findings could be made * * *."

More recently, this Court in its opinion by Mr. Justice Murphy said in *Lavender* v. *Kurn*, 327 U. S. 645, 653, 90 L. Ed. 916 (1946):

"It is no answer to say that the jury's verdict involved speculation and conjecture. Whenever facts are in dispute or the evidence is such that fair-minded men may draw different inferences, a measure of speculation and conjecture is required on the part of those whose duty it is to settle the dispute by choosing what seems to them to be the most reasonable inference. *Only when there is a complete absence of probative facts to support the conclusion reached does a reversible error appear.* But where, as here, there is an evidentiary basis for the jury's verdict, the jury is free to discard or disbelieve whatever facts are inconsistent with its conclusion. *And the appellate court's function is exhausted when that evidentiary basis becomes apparent, it being immaterial that the court might draw a contrary inference or feel that another conclusion is more reasonable.*" (Emphasis supplied.)

The Trial Court below found that Wittenberg produced a "new result" and that his contribution to the art constituted an invention. Both of these findings are findings of fact. *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 367, 86 L. Ed. 1537 (1942); *United States* v. *Esnault-Pelterie*, 299 U. S. 201, 81 L. Ed. 123 (1936), 303 U. S. 26, 82 L. Ed. 625 (1938). The Circuit Court of Appeals reversed both of these findings on the ground, as the court expressed it, "we think" the con-

trary. This decision of the Circuit Court of Appeals reversing the District Court on questions of fact is clearly contrary to the Federal Rules of Civil Procedure and is in conflict with the decisions of this Court referred to above. Moreover, this decision is in conflict with decisions of other Circuit Courts of Appeal.

In *Arnstein* v. *Porter*, 154 Fed. (2d) 464, 474 (1946) the Circuit Court of Appeals for the Second Circuit reviewed a judgment in a copyright case. The Court, in its opinion by Judge Frank, said as to the relative spheres of the trial court and the court of review:

> "* * * Where the facts are thus in real dispute, it is our function, after a trial in the lower court, to review its legal conclusions and, with reference to its findings of fact, to determine not whether we would ourselves have made them, but merely whether they rest on sufficient evidence in the record. When the trial occurs before a judge without a jury, we have his findings of fact separated from his legal conclusions; when it occurs before a jury, our task is somewhat different, especially when the jury returns a general (i. e., composite) verdict. But in reviewing a judgment after either type of trial, ours must be a limited function. This is not, and must not be, a trial court. Such a court has a duty more difficult and important than ours. We begin our task where it leaves off."

In *Lincoln Stores, Inc.* v. *Nashua Manufacturing Co.*, 157 F. (2d) 154 (1946), the Circuit Court of Appeals for the First Circuit affirmed a judgment, in part, of validity and infringement. The Court, in its opinion by Judge Mahoney, called attention to the rule that the question of invention is one of fact and continued in its opinion at p. 163:

> "* * * The presumption of the validity of Amory's patent arising from its issuance, *Mumm* v. *Jacob E. Decker & Sons*, 1937, 301 U. S. 168, 171, 57 S. Ct. 675, 81 L. Ed. 983, taken together with the many years of effort to produce what Amory produced and its sub-

stantial commercial success, makes it impossible for us to say that the district court was clearly erroneous in deciding that Amory had produced a patentable invention. Rule 52(a), F.R.C.P., 28 U.S.C.A. following section 723c".

The decision of the Circuit Court of Appeals below is clearly in conflict with the decision of the Circuit Court of Appeals for the First Circuit in *Lincoln Stores* v. *Nashua Manufacturing Co., supra.* The Circuit Court of Appeals below did not state as did the Circuit Court of Appeals for the First Circuit that the presumption of validity taken together with the years of effort to produce what Wittenberg produced and its substantial commercial success "makes it impossible for us to say that the District Court was clearly erroneous." The Circuit Court of Appeals below reversed saying, "we think" differently from what the Trial Court thought.

Attention is also directed to *Hazeltine Corporation* v. *General Motors Corporation*, 131 Fed. (2d) 34 (1942) in which the Circuit Court of Appeals for the Third Circuit affirmed a judgment for the defendant in a patent case. The Court pointed out in its opinion by Judge Goodrich that the question of invention is one of fact and the Trial Court's finding that the patent lacked invention was "supportable in view of the evidence." It is evident that the Circuit Court of Appeals below did not confine its inquiry to the proper functions of a court of review, to-wit, determining whether or not the fact findings of the Trial Court were "supportable in view of the evidence."

The proper interpretation to be given to Rule 52a of the Federal Rules of Civil Procedure is a matter of great importance to litigants. The numerous petitions for certiorari which, in the last term of this Court, have been filed in an effort to get this Court to pass upon the question bear

witness to the importance of the question.* Although the lower courts have repeatedly discussed Rule 52a, this Court has not interpreted the rule and its key words "clearly erroneous." Does the rule require affirmance, even though the Circuit Court of Appeals might have found differently had it been the trier of fact, so long as there is some evidence to support the findings? Such was the opinion of the Circuit Courts of Appeal in the decision just discussed. Or does Rule 52a give the Circuit Court of Appeals latitude to reverse in any case in which it would have found the facts differently? Such was the action of the Circuit Court of Appeals below.

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* Docket No. 121. *Dieckhaus* v. *Twentieth Century Fox Film Corporation* (153 F. (2d) 893, CCA 8, 1946) No. 1260 Oct. Term, 1945, Cert. Denied October 14, 1946, 329 U. S. 716, 91 L. Ed. 37.

Docket No. 128. *Liberty Mutual Ins. Co.* v. *Pillsbury*, (154 F. (2d) 559, CCA 9, 1946) No. 1272 Oct. Term 1945, Cert. Denied Oct. 14, 1946, 329 U. S. 717, 91 L. Ed. 38.

Docket No. 158. *J. E. Haddock, Ltd.* v. *Pillsbury*, (154 F. (2d) 1018, CCA 9, 1946) Cert. Den. Oct. 14, 1946, 329 U. S. 729, 91 L. Ed. 39, Rehearing Denied 11-12-46, ... U. S. ..., 91 L. Ed. 84.

Docket No. 321. *Chatz* v. *Armour Plant Employees Credit Union*, (154 F. (2d) 236, CCA 7, 1946) Cert. Den. 10-14-46, 329 U. S. 728, 91 L. Ed. 42, Rehearing Denied 11-12-46, 329 U. S. 827, 91 L. Ed. 85.

Docket No. 322. *Chatz* v. *Todd*, (154 F. (2d) 236, CCA 7, 1946) (Consolidated with 321) Cert. Den. 10-14-46, 329 U. S. 728, 91 L. Ed. 42, Rehearing Denied 11-12-46, 329 U. S. 827, 91 L. Ed. 85.

Docket No. 438. *Harris-Stanley Coal & Land Co.* v. *Chesapeake & Ohio R. R. Co.*, (154 Fed (2d) 450, CCA 6, 1946) Cert. Den. 10-21-46, 329 U. S. 761, 91 L. Ed. 64.

Docket No. 527. *Lorraine Coffee Company, Inc. et al.* v. *LaTouraine Coffee Co., Inc.*, (157 F. (2d) 115, CCA 2, 1946) Cert. Den. 11-12-46, 329 U. S. 771, 91 L. Ed. 75.

Docket No. 560. *Dixi-Cola Laboratories, Inc. et al.* v. *Coca-Cola Company*, (155 F. (2d) 59, CCA 4, 1946) Cert. Den. 11-12-46, 329 U. S. 773, 91 L. Ed. 75.

Docket No. 561. *Coca-Cola Company* v. *Dixi-Cola Laboratories, Inc. et al.*, (155 F. (2d) 59, CCA 4, 1946) Cert. Den. 11-12-46, 329 U. S. 773, 91 L. Ed. 75.

Docket No. 660. *Union Producing Co.* v. *White et al.*, (157 F. (2d) 254, CCA 5, 1946) Cert. Den. 12-16-46, 329 U. S. 792, 91 L. Ed. 241.

Docket No. 700. *Borg-Warner Corp. et al.*, v. *Goodwin et al.*, (157 F. (2d) 267, CCA: 6, 1946) Cert. Den. 1-6-47, 329 U. S. 799, 91 L. Ed. 373, Rehearing Denied 2-3-47, 329 U. S. 835, 91 L. Ed. 555, Second Pet. for Rehearing Denied 6-23-47, ... U. S. ..., 91 L. Ed. 1607.

Docket No. 740. *The Foxboro Company* v. *Taylor Instrument Companies*, (157 F (2d) 226, CCA 2, 1946) Cert. Den. 1-6-47, 329 U. S. 800, 91 L. Ed. 374.

Docket No. 976. *Royal Packing Co.* v. *Porter*, (157 F. (2d) 524, CCA 8, 1946) Cert. Den. 3-17-47, ... U. S. ..., 91 L. Ed. 790.

THE CIRCUIT COURT OF APPEALS DREW IMPROPER CONCLUSIONS FROM THE PATENT OFFICE HISTORY IN CONFLICT WITH DECISIONS OF OTHER CIRCUIT COURTS OF APPEALS.

In its opinion the Circuit Court of Appeals below discussed the Patent Office history of the Wittenberg patent application and applied it in a manner which is unwarranted in law or fact and in conflict with decisions of other Circuit Courts of Appeal. The Court below stated in its opinion (R. p. 371):

> "* * * There is some confusion in the authorities as to the importance which may properly be attached to an amendment by which the allowance of a patent has been procured."

What the Circuit Court of Appeals referred to as "confusion in the authorities" might more properly be expressed as "conflict of authorities," a conflict between the decision below and decisions of other Circuit Courts of Appeal.

The question presented has never been discussed by this Court and has never been decided—save in the sense that on a similar record this Court has never applied the reasoning applied by the Court below. The question has been passed upon by the Circuit Courts of Appeal of the Second and Sixth Circuits, with whose decisions the decision below is in conflict.

In the prosecution of a patent application, involving patentable subject matter, the principal effort of the applicant and the Patent Office examiner is to arrive at the proper definition, in the claim, of the invention. Due at times to lack of complete knowledge of the prior art in advance of application, and due also to the limitations of language, the applicant frequently is required to amend

his claims. The question here presented is the significance of such amendments when considering *validity* in an infringement suit.

The significance of an amendment when considering the issue of *infringement,* has been discussed by this Court in numerous decisions. When applying a claim to an alleged infringement, matter added to the claim by amendment to avoid the prior art is strictly construed. This is the commonly termed "file wrapper estoppel." (*Exhibit Supply Co.* v. *Ace Patents Corporation,* 315 U. S. 126, 86 L. Ed. 736 (1942); *Keystone Driller Company* v. *Northwest Engineering Corp. et al,* 294 U. S. 42, 79 L. Ed. 747 (1935).

Although this Court has frequently applied the "file wrapper estoppel" doctrine on the issue of *infringement,* it has never applied any estoppel on the issue of *validity.* The reasons are fundamentally that a claim should be measured by the prior art as it existed *in fact,* and there is no basis in logic or justice for establishing any synthetic "prior art" by an alleged estoppel.

The Court below quoted with approval from one of its previous decisions which announced a rule that invention may be judged on the basis of the last amendment in the Patent Office. The reasoning was: the claim prior to amendment was not allowed, so without amendment there was no invention; the only question is, therefore, as to whether the last amendment gave patentability to what was not otherwise patentable. This reasoning overlooks the realities of Patent Office practice. The gist of the invention is ordinarily embodied in the claim as originally filed, but may be imperfectly or inaccurately expressed. The claim which is finally allowed should be judged in its final form, and compared with the prior art *as it existed in fact.* The reasoning of the Court below sets up a pseudo or synthetic

prior art, by treating a claim prior to amendment as though it were prior art. Other Circuit Courts of Appeal have held to the contrary.

In *International Cellucotton Products Co.* v. *Sterilek Co., Inc.*, 94 F. (2d) 10 (1938), the Circuit Court of Appeals of the Second Circuit passed upon a similar question. Sufficient of the facts and the decision by the Circuit Court of Appeals for the Second Circuit appear in a portion of the opinion of that Court by Judge Learned Hand at p. 12:

> "* * * However, the examiner cited against these claims, as well as against claim 19 the 'Johnson & Johnson machine,' which we have just mentioned, but about whose structure the file-wrapper tells very little. To escape this reference Bauer limited the claims in suit to a machine in which the gauze ran at right angles to the filler web, just as he introduced into claim 19, the other clause just considered. The defendant bases its case very largely on the assumption that by so doing he conceded that the prior art anticipated the claims except for this interpolated feature. This has been sometimes said in the case of disclaimers, which are in substance limitations imposed after issue; but it is a mistaken view of the law. When an inventor consents to limit his monopoly, there is no reason in fact to impute to him the belief that his only patentable advance lies in the element so introduced. He may merely think that he still retains enough for practical purposes, and that the examiner's insistence does not justify the expense of an appeal. Nor is there any reason to impose upon him the same consequence as though he had formally so conceded; it is enough that he has freed the art except as the claim reads, and that he has surrendered any power under the doctrine of equivalents to resume what he has given up. He has done nothing which need prevent him from insisting in support of the claim as allowed that his invention was broader than the examiner supposed; he is not confined to the examiner's reasoning, or committed to his mental processes. *United Chromium* v. *International Silver Co.*, 2 Cir., 60 F. 2nd 913, 915."

See also *Katz* v. *Horni Signal Manufacturing Corp.*, 145 F. (2nd) 961 (CCA 2, 1944) in which the Court pointed out that the use of the file wrapper is restricted to questions of infringement and as to whether a patentee who seeks to disavow an element in the claim was forced to introduce it in order to avoid rejection. The decision of the Circuit Court of Appeals below is in conflict with these two decisions, as well as many others of the Circuit Court of Appeals of the Second Circuit. In the Second Circuit a file wrapper may be used only on the question of infringement and only when there is a strict file wrapper estoppel. The decisions of this Court, likewise, have gone no farther in the use of the file wrapper than to permit its use where there is an amendment and a strict estoppel. The use made of the file wrapper in this Court has likewise been on the issue of infringement. The decision of the Circuit Court of Appeals below is clearly in conflict.

The decision of the Court below is also in conflict with *W. S. Godwin Co.* v. *International Steel Tie Co.*, 2 F. (2d) 198 (1924) in which the Circuit Court of Appeals for the Sixth Circuit considered the proper use of the file wrapper. In its opinion by Judge Denison the Circuit Court of Appeals for the Sixth Circuit, at p. 199 said:

> "In its progress through the Patent Office claim 4, with others, was rejected on reference to Freese. It was thereupon amended to include the guard limitation finally found in it, 'extending to the upper edge of the roadway and forming a boundary therefor,' and it was pointed out that the application was distinguished from Freese by this additional limitation. It is said that since there was no invention in this mere limitation or modification, and that since the applicant rested his case thereon, he cannot now be heard to say that invention may be found elsewhere in, or in connection with, the device."

"The familiar rule of estoppel by Patent Office proceedings is invoked. This rule does not reach the case. The patentee may not later have such a construction of his claim that it will cover the device which has been thus protected by his confession and avoidance; but so long as he does not seek thus to broaden his claim, we do not know of any principle or authority which would bar him from claiming that his device was in fact patentable for other reasons than the one shown by his amendment. The conclusion of the Examiner to grant a particular claim, like the conclusion of an equity trial court to enter a particular decree, will be approved, if it was right, although the reason given is not sound. See *Campbell Co.* v. *Pomeroy Co.* (D.C., 300 F. 872, 873, Learned Hand, D. J."

The error of the Court below in its use of the file wrapper also appears from a consideration of the final amendment which is discussed by the Court below. Before the last amendment, three claims were rejected as unpatentable over a combination of three different patents (R. p. 209). In the final amendment words were added which required that the cams of the pressure cooker be concealed when the cover was on the body of the cooker, and in one instance that there be an unbroken circumferential line between the cover and body. A reference to this amendment was made in the remarks of the patent solicitor as pointed out by the Court below. However, the major portion of the remarks accompanying the amendment as appears in R. pp. 211 to 213 are directed to the proposition that as a matter of law the Examiner was in error in rejecting on the three references and further to showing that even if the three references were combined they would not produce Wittenberg's structure. Thus, final allowance came after argument, first, that the previous rejection on a combination of three references was improper on the basis of the authorities; second, that the rejection was improper because in

fact the three references could not be combined and their alleged combination would not produce the structure of Wittenberg; third, there were amendments made as to the concealment of the cams, etc. The file wrapper does not show which of these three approaches secured the allowance of the claims. The Circuit Court of Appeals below has assumed, first, that allowance was secured merely by the amendment to the claim that the persuasive arguments made by the applicant, quite apart from the amendment, were of no significance. This assumption is unwarranted. Further, the Circuit Court of Appeals has assumed that the claims before amendment defined the prior art. This assumption likewise is not warranted and is directly contrary to the decisions of the Circuit Courts of Appeals of the Second and Sixth Circuits to which reference has been made. As was pointed out by the Circuit Court of Appeals for the Sixth Circuit in Judge Denison's opinion, the rule of file wrapper estoppel "does not reach the case" and further "we do not know of any principle or authority which would bar him from claiming that his device was in fact patentable for other reasons than the one shown by his amendment." In the case at bar, three reasons for patentability were urged in the last amendment. The Circuit Court of Appeals for the Sixth Circuit would consider any one of those three reasons, plus any other reasons which might be urged for patentability. The Court below seized upon one only, and finding it inadequate, held the patent invalid.

The conflict with the opinion of the Circuit Court of Appeals for the Second Circuit in *International Cellucotton Products Co.* v. *Sterilek Co., Inc., supra,* is likewise clear. That court in its opinion by Judge Learned Hand applied the rule that "there is no reason in fact to impute to him

the belief that his only patentable advance lies in the elements so introduced" by amendment. A reading of the entire file wrapper of the Wittenberg patent shows that the patent owner desired issuance at as early a date as possible. An affidavit was filed to make the case special (R. p. 181). The subsequent infringement by the defendant and others (R. p. 70-71) justify the haste of the patent owner. Under these circumstances with the claims standing rejected, the owner of the Wittenberg patent was justified in thinking that the claims, even with amendment, would be enough for practical purposes and that there was not justification for the time and expense of an appeal.

It is respectfully submitted that this Court should pass upon the question as to the significance which may be properly attached to an amendment prior to final allowance of a claim.

As pointed out in the opinion of the Court below, there is "some confusion in the authorities"—i. e. conflict—as to this point. This Court has never expressly passed on the question, having limited its consideration of the file wrapper to questions of infringement.

Conclusion.

For the foregoing reasons, it is respectfully submitted that this petition should be allowed and the judgment of the Circuit Court of Appeals for the Seventh Circuit reviewed and reversed.

Respectfully submitted,

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